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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,514	04/19/2004	Christopher Szeto	017887-013000US	4298

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MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

CABUCOS, MARIE G

ART UNIT	PAPER NUMBER
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2163

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/828,514

Applicant(s)

SZETO ET AL.

Examiner

Marie Antoinette Cabucos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/19/04 and amendment filed 12/22/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-21 are directed towards method steps, which can be practiced mentally in conjunction with pen and paper, therefore, they are directed to non-statutory subject matter. The claimed methods appear to be directed at software per se that is non-statutory subject matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Jean Pierre De Vries (US Patent no. 6,968,179).

Regarding claims 1, 11 and 21, De Vries discloses in figures 2, 3 and 11 a method, computer system and apparatus for performing an Internet search launched

from an instant messaging application (col. 1 and 2), comprising providing a first IM user with an option to launch an Internet search of a second IM user directly from the IM application; transmitting a search query identifying the second IM user to a search server; searching the Internet for web pages matching the search query to generate search results using the search server (figure 11); accessing a user profile of the second IM user from an IM member profile database (100); sorting the search results in order of relevance to information in the user profile of the second IM user; and displaying the sorted search results to the first IM user (figure 3).

4. Regarding claims 2-4 and 12-14, De Vries discloses in figures 2, 3 and 11 a method, computer system and apparatus for performing an Internet search launched from an instant messaging application according to claim 1, further comprising providing the first IM user with an option to launch an Internet search from the IM application based on a topic (col. 2, lines 3-13); and transmitting a second search query identifying the topic to the search server (col. 8, lines 6-67); further comprising searching the Internet for web pages matching the second search query to generate second search results using the search server; and displaying the second search results to the first IM user (figure 11); and wherein displaying the search results further comprises displaying the user profile along with the search results (figure 3).

5. Regarding claims 5-7 and 15-17, De Vries discloses in figures 2, 3 and 11 a method, computer system and apparatus for performing an Internet search launched from an instant messaging application according to claim 2, wherein providing the first IM user with the option to launch the Internet search from the IM application based on

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the search query further comprises automatically displaying a string that identifies the second IM user in a dialog box (figure 3 and 11); wherein the string is a name that is accessed from an electronic address book; and wherein the string is a identification number that identifies the user profile (302, figure 1- phone number, computer's IP).

6. Regarding claims 8-10 and 18-20, De Vries discloses in figures 2, 3 and 11 a method, computer system and apparatus for performing an Internet search launched from an instant messaging application according to claim 1, wherein transmitting the search query to the search server further comprises transmitting a URL that contains an ID identifying the second IM user to the search server (figure 1); wherein providing the first IM user with the option to launch the Internet search from the IM application further comprises providing a search option on a tool bar or drop down list on a screen displayed by the IM application (figure 11); and wherein the sorted search results are displayed in a web browser window generated by a web browser application (col. 5, lines 5-20).

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

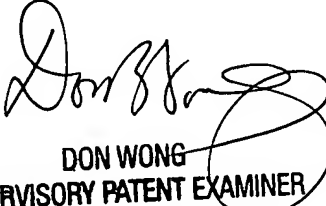
Prior art of record James A. Roskind (US Publication no. 2003/0065721) discloses a passive personalization of buddy lists.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie Antoinette Cabucos whose telephone number is 571-272-8582. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don K. Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DON WONG
SUPERVISORY PATENT EXAMINER
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Marie Antoinette Cabucos
Examiner
Art Unit 2163